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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNI79.013AUS	6418
20995 7590 07/07/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
07/07/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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# Office Action Summary

**Application No.**

10/618,957

**Applicant(s)**

YAMAMOTO ET AL.

**Examiner**

Victor S. Chang

**Art Unit**

1794

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8 and 10-18 is/are pending in the application.  
4a) Of the above claim(s) 13, 16 and 17 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 8, 10-12, 14, 15 and 18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. Applicants' amendments and remarks filed on 4/8/2008 have been entered. Claims 8 and 14 have been amended. New claim 18 has been entered. Claims 8, 10-12, 14, 15 and 18 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

### ***Rejections Based on Prior Art***

4. Claims 8, 10-12, 14 and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Masuda [US 20020064650A1].

Masuda's invention relates to a protective film for window application [0002]. The film comprises a polyester film, an antistatic coating on at least one side of the film, and a hard coat may be provided on the antistatic coating. The antistatic coating has a specific surface resistance of not more than  $1.0 \times 10^{13} \Omega$ . The antistatic coating is provided to eliminate static electricity pattern, which causes non-uniformity in the hard coat. The film has a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent) [0009, 0013 and 0040]. Examples of the antistatic agents include polymers having a backbone containing pyrrolidinium rings

(repeating units) [0031]. On the side opposite from the hard coat of the polyester film, an adhesive is applied for pasting the film on window glass [0044].

For claim 8, since Masuda teaches a protective film of the same structure and composition as the claimed invention, its transparency after heat treatment is deemed to be inherent to the same chemistry. Regarding the use language in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

For claims 10 and 11, Masuda teaches that the thickness of the adhesive layer is 15 microns [0099], which reads on the claimed range of 3-100 microns or 5-40 microns.

For claim 12, Masuda teaches that the polyester film comprises polyethylene terephthalate, etc. [0017].

For claim 14, the entirety of the film is deemed to be transparent, as evidenced by its use for window application.

For claim 18, the use language “wherein the adhesive layer is attached on a surface of a hard coat layer, anti-glare layer, or conductive thin film” does not serve to distinguish structure over the prior art, it has not been given any patentable weight.

5. Claims 8, 10-12, 14, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda’s admitted prior art in view of Masuda [US 20020064650A1].

Masuda’s invention relates to a protective film for window application [0002]. Masuda admitted in the Background section it is known that polyester films as such are mostly of a layer structure in which usually a hard coat is provided on one side while a paste (adhesive) is applied

on the opposite side [0003-0004]. A static eliminator for getting rid of the pattern of static electricity on the film surface is used to eliminate coating irregularity [0005].

For claim 8, Masuda teaches an alternative method to eliminate the coating irregularity by forming a protective film comprising a polyester film, an antistatic coating on at least one side of the film, and a hard coat may be provided on the antistatic coating. The antistatic coating has a specific surface resistance of not more than  $1.0 \times 10^{13} \Omega$ . The antistatic coating is provided to eliminate static electricity pattern, which causes non-uniformity in the hard coat. The film has a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent) [0009, 0013 and 0040]. Examples of the antistatic agents include polymers having a backbone containing pyrrolidinium rings (repeating units) [0031]. On the side opposite from the hard coat of the polyester film, an adhesive is applied for pasting the film on window glass [0044]. It would have been obvious to one of ordinary skill in the art to substitute the static eliminator in making Masuda's admitted known protective film with the antistatic coating of Masuda, because the selection of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Regarding the transparency after heat treatment, since the collective teachings of prior art render the structure and composition of the claimed invention obvious, its transparency after heat treatment is deemed to be inherent to the same chemistry. Regarding the use language in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

For claims 10 and 11, Masuda teaches that the thickness of the adhesive layer is 15 microns [0099], which reads on the claimed range of 3-100 microns or 5-40 microns.

For claim 12, Masuda teaches that the polyester film comprises polyethylene terephthalate, etc. [0017].

For claim 14, the entirety of the film is deemed to be transparent, as evidenced by its use for window application.

For claim 15, since Masuda's admitted prior art teaches that "usually a hard coat is provided on one side", it interpreted that the hard coat is optional. It would have been obvious to one of ordinary skill in the art to modify an adhesive protective film of the admitted prior art with an outer antistatic layer of Masuda, motivated by the desire to avoid fouling from air dust [0006].

For claim 18, the use language "wherein the adhesive layer is attached on a surface of a hard coat layer, anti-glare layer, or conductive thin film" does not serve to distinguish structure over the prior art, it has not been given any patentable weight.

#### ***Response to Arguments***

5. It should be noted that in the Office action mailed 1/9/2008 the grounds of rejection was set forth under 35 USC 102(e), whereas in the reply filed 4/8/2008 applicants state that the rejections was under 102(b) [Remarks page 5]. Upon a careful review, since Masuda reference is published 5/30/2002, and the priority date of the instant application is 8/9/2002, the rejections are corrected as under 102(a). Since the applied reference has not been changed, it is believed that the inadvertent error has not caused any harm to applicants.

Applicants argue at Remarks page 6 that

“Claims 8 and 14 recite that the film comprises a transparent adhesive layer formed on and in contact with one side of the base material film. Masuda, in contrast, discloses adhesive attached on one side to an antistatic coating, and on the other side, the adhesive is not attached to any layer, so as to be accessible for pasting the film on window glass. Masuda at paragraph [0044].”

However, Masuda’s invention is not limited to the embodiment taught in [0044]. Since Masuda teaches that the antistatic coating is applied on at least one side of the film, and also teaches in [0044] “it is preferable that the said antistatic coating be provided on both sides”, Masuda’s teachings are interpreted as necessarily requiring an antistatic coating on the side to be hard coated, and preferably (but not required) having an antistatic coating on the side which carries an adhesive coating. In other words, Masuda’s teaching encompasses and anticipates the structural relationship of the claimed invention. Applicants’ argument directed to embodiment not relied upon is unpersuasive. Further, a new grounds of rejection over Masuda’s admitted prior art in view of Masuda also render the structural relationship of the claimed invention obvious as set forth above.

Referring to claim 16, applicants argue at pages 6-7 that

“Masuda does not disclose a film that has a transparent adhesive layer, base material film, and the transparent antistatic layer, but not a hard coat layer.”

However, since Masuda’s admitted prior art teaches that “usually a hard coat is provided on one side”, it is interpreted that the hard coat is optional. It would have been obvious to one of ordinary skill in the art to modify an adhesive protective film of the admitted prior art with an outer antistatic layer of Masuda, motivated by the desire to avoid fouling from air dust.

Referring to claim 18, applicants argue at page 7 that

“Masuda does not teach an adhesive layer attached on a surface of a hard coat layer, anti-glare layer, or conductive thin film.”

However, the claim language ““wherein the adhesive layer is attached on a surface of a hard coat layer, anti-glare layer, or conductive thin film” is interpreted as a use limitation. Since usage does not serve to distinguish structure over the prior art, it has not been given any patentable weight.

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794